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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/159,843	09/24/98	MELBY	C-2047DA

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IM11/1125

EXAMINER
MICHL, P

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 11/25/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8, 10, 14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8, 10, 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer '758 or Peiffer '288 or Peiffer '916. It remains the Examiner's position that polymers of either APTAC or MAPTAC and either acrylic acid, methacrylic acid, or the particular sulfonic acid would be obvious to one of ordinary skill in the art. Applicants' arguments and Declaration submitted in the parent application have been considered but are not persuasive. Applicants argue that the claims are directed to only copolymers. This argument is not persuasive because the claims recite "polymer". The claims also recite "comprising". Polymers comprising the required two groups of monomers and having third monomers even in major proportions are within the scope of the claims. There is no limitation in these claims which would exclude the possible presence of other non-recited monomers. The Declaration is not commensurate in scope with the claims. The claims are directed to polymers. The Declaration is

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not directed to the properties of the claimed polymers per se. The Declaration appears to be directed to the properties of a shampoo which comprises a polymer. Properties of a shampoo are not at issue. The Declaration is directed to the patentability of method claims 9 and 11-13 which have been cancelled. The Declaration does not contain any evidence directed to polymers of APTAC or MAPTAC and either acrylic acid, methacrylic acid or the particular sulfonic acid according to the Peiffer references.

Claims 1-8, 10 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 11-13 of copending application Serial No. 08/828,495. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application are directed to the same invention as the allowed claims 9 and 11-13 of Serial No. 08/828,495. Applicant improperly refers to this application as a division of 828,495. This application is not a division of 828,495. This application is properly a continuation of 828,495. In 828,495 there was no restriction requirement. All of the claims presented in 828,495 were examined. It is only proper to term a continuing application a "division" when restriction has been required in the parent application. Applicants are requested to amend this specification to state that it is a continuation of 828,495. The Examiner suggests a terminal

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disclaimer be submitted to obviate this provisional obviousness-type double patenting rejection.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to Paul Michl at telephone number (703) 308-2451.

The Examiner's supervisor is Vasu Jagannathan phone number (703) 306-2777. The fax number for this group is (703) 305-3599.

PRMichl:cdc

(703) 308-0661

November 23, 1998



PAUL R. MICHL
PATENT EXAMINER
ART UNIT 156